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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,622	01/24/2000	Stuart Edwards	STUA0010	7398
7590 02/09/2005				
GLENN PATENT GROUP 3475 EDISON WAY SUITE L MENLO PARK, CA 94025			EXAMINER MAIORINO, ROZ	
			ART UNIT 3763	PAPER NUMBER

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/490,622

Applicant(s)

EDWARDS, STUART

Examiner

Roz Maiorino

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3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 8, 14, 18-20 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) 4, 5, 7, 9-17, 21, 22 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8, 14, 18-20 and 23-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-3, 6, 8, 14, 18-19, 25-29, 32-37 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Pub No. US Patent NO. 5971983 to Lesh.

Lesh teaches a method of treatment by inserting a catheter into a localized region of the body, discharged from the catheter a substance capable of perfusing into some tissue allowing the substance to perfuse into a tissue of said localized region; emitting

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form the catheter energy of a frequency and in an amount effective to cause a temperature change in said substance and contracting a dilatation in the tissue.

2. Claims 1-3,6, 8, 14, 18-19, 25-29, 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Pub No. 2004/0097901 to Whalen, II et al.

Whalen teaches a method of treatment by inserting a catheter into a localized region of the body, discharged form the catheter a substance capable of perfusing into some tissue allowing the substance to perfuse into a tissue of said localized region; emitting form the catheter energy of a frequency and in an amount effective to cause a temperature change in said substance and contracting a dilatation in the tissue.

3. Claims 1-3,6, 8, 14, 18-19, 25-29, 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Pub No. US 4994069 to Ritchart et al.

Richart teaches a method of treatment by inserting a catheter into a localized region of the body, discharged form the catheter a substance capable of perfusing into some tissue allowing the substance to perfuse into a tissue of said localized region; emitting form the catheter energy of a frequency and in an amount effective to cause a temperature change in said substance and contracting a dilatation in the tissue.

4. Claims 1-3,6, 8, 14, 18-19, 25-29, 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Pub No. US2002/0156531 A1 to Felt et al.

Felt teaches a method of treatment by inserting a catheter into a localized region of the body, discharged form the catheter a substance capable of perfusing into some tissue allowing the substance to perfuse into a tissue of said localized region; emitting form the catheter energy of a frequency and in an amount effective to cause a temperature

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change in said substance and contracting a dilatation in the tissue. (figures 1-10 and Paragraph 0310).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20, 23-24, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Pub No. US2002/0156531 A1 to Felt et al as applied to claim 1 above, and further in view of US Patent No. 5916235 to Guglielmi.

As mentioned above Felt teaches the invention except for promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors. Guglielmi teaches promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined these studies because epithelial growth allows for a decrease healing time and pressure/temperature/ or pressure sensors allows the physician to have more control over his/her operation.

6. Claims 20, 23-24, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Pub No. US 4994069 to Ritchart applied to claim 1 above, and further in view of US Patent No. 5916235 to Guglielmi.

As mentioned above Ritchart teaches the invention except for promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors. Guglielmi teaches promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined these studies because epithelial growth allows for a decrease healing time and pressure/temperature/ or pressure sensors allows the physician to have more control over his/her operation.

7. Claims 20, 23-24, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Pub No. US 2004/0097901 to Whalen II et al applied to claim 1 above, and further in view of US Patent No. 5916235 to Guglielmi.

As mentioned above Whalen teaches the invention except for promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors. Guglielmi teaches promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined these studies because epithelial growth allows for a decrease healing time and pressure/temperature/ or pressure sensors allows the physician to have more control over his/her operation.

8. Claims 20, 23-24, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Pub No. US 5971983 to Lesh applied to claim 1 above, and further in view of US Patent No. 5916235 to Guglielmi.

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As mentioned above Lesh teaches the invention except for promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors. Guglielmi teaches promotion of epithelial cell growth, monitoring the operation with pressure/temperature/ or pressure sensors.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined these studies because epithelial growth allows for a decrease healing time and pressure/temperature/ or pressure sensors allows the physician to have more control over his/her operation.

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-3, 6, 8, 14, 18-20, 23-37 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 11/18/2004 have been fully considered but they are not persuasive. Applicant alleges Felt does not deliver a substance that is capable of perfusing into at least some tissue, however Felt delivers adhesives which are capable of perfusing into at least some tissue.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 571- 272-4960. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4377. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM



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